

Remarks

Applicants hereby provisionally elect Group V (claims 21-32), with traverse.
Reconsideration of the Restriction Requirement in all aspects is requested in view of the following remarks.

Examiner has requested applicants to elect one of the following groups of claims:

Group I, claims 1-9 and 33-38 drawn to pharmaceutical compositions comprising compound of structure I;

Group II, claims 10-12, 19-20 and 47, drawn to extract of tissues from *Forsteronia refracta* and method for preparing the extract;

Group III, claims 13-16, drawn to a method of inhibiting Rsk activity with a compound of formula III;

Group IV, claims 17-18, drawn to a method of screening for Rsk activity;

Group V, claims 21-32, drawn to a method of treating a disease or a condition characterized by inappropriate Rsk activity; and

Group VI, claims 39-46, drawn to Method of detecting neoplastic cells.

Response to Restriction Requirement

First, Applicants note that the unity of all claims of the application is evidenced by the International Preliminary Examination Report dated August 12, 2004 and mailed September 7, 2004, where unity of invention among all claims was found.

Next, Applicants elect Group V (claims 21-32), with traverse, requesting that Groups III (claims 13-16) and Group I (claims 1-9 and 33-38) be combined with Group V.

The Examiner asserts that the inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT rules 13.1-13.3 and that these groups do not share special technical features. Applicants assert that Groups V, III, and I do encompass a single general inventive concept and share special technical features.

37 C.F.R. 1.475(a) states that unity of invention under PCT Rule 13 is satisfied when there is a technical relationship among those inventions defined by the claims which involves "one or more of the same or corresponding special technical features." This unifying special

technical feature is that which defines a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. PCT Rule 13.2 and the PCT Administrative Instructions, Annex B, Part 1(b).

Here, the special technical feature is the compound I, or its derivative, compound III. All claims in Groups V, III, and I contain this feature.

Group V utilizes a compound having the general structure of compound III for treating a disease or disorder characterized by inappropriate Rsk activity, while Group III also utilizes compound III for inhibiting Rsk activity. Thus, both groups V and III do have the same general technical feature regarding compound III and regulation of Rsk activity. Group I claims (1-9 and 33-38) encompass a pharmaceutical composition comprising the generic compound I, of which compound III is a species. Furthermore, dependent claim 6 of Group I, and the claims which depend from claim 6, all recite compound III. Thus, all claims of Groups V, III, and I encompass a compound having the general structure of compound III, or of its parent structure, compound I, while Groups V and III further encompass the use of the compound to regulate Rsk activity. Therefore, Groups V, III, and I are not patentably distinct, and searching one of these groups regarding either structure I or III, would necessarily encompass the claims of the other two groups. That is, the search for one group of Groups V, III, and I, would be coextensive with the other, does not require independent searches, and furthermore does not entail a burdensome search.

Claims which possess a unifying special technical feature and which are drawn to a product and process of use of said product have unity of invention. 37 C.F.R. 1.475(b)(2). PCT Rule 13 does not prohibit product and process of use claims from being examined in a single application, even if both the claimed product and process can be used separately, in materially different ways. Rather, PCT Rule 13 allows for such claims to be examined together in a single application if all claims contain the same or similar technical feature. Thus, the Group V, III, and I claims, which possess the unifying special technical feature described above, have unity of invention.

Conclusion

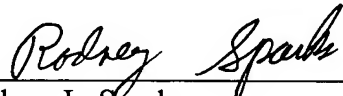
Because all claims of Groups V, III, and I have the same special technical feature, and the claimed generic or species product in Group I is used in Groups V and III, the pending claims of Groups V, III, and I have unity of invention. Applicants request that the Group V, III, and I claims be rejoined for examination on the merits under 37 C.F.R. 1.475(b)(2).

Based on the foregoing, Applicants respectfully request reconsideration and withdrawal of the restriction requirement, to the extent described above.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (434) 243-6103.

Respectfully submitted,

Date: October 20, 2005


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